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EXAMINER
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ABRAHAM, AMJAD A

ART UNIT	PAPER NUMBER
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1791

NOTIFICATION DATE	DELIVERY MODE
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04/13/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@techlaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/598,379	<b>Applicant(s)</b> STOLARCZYK ET AL.	
	<b>Examiner</b> AMJAD ABRAHAM	<b>Art Unit</b> 1791	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01/20/2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicant's remarks and amendments, filed on January 20, 2010 have been carefully considered. Claims 9 and 19 are currently amended. Claims 22-24 are newly added claims. Thus claims 1-24 are pending review in this action.

### ***Priority***

1. **Applicant's Priority Argument**

a. Applicant has argued (See Applicant's remarks on January 20, 2010) that the Giorgini reference is not prior art because its earliest publication date (September 9, 2004-from the US Pre-Grant Publication) is not earlier than the earliest priority date of the instant application (March 24, 2004- from Provisional 60/556,209).

2. **Examiner Response to Priority Issue**

b. Prior Art is not restricted to publication dates. **(See 35 USC 102(e))**. 35 U.S.C. 102(e), in part, allows for certain prior art (i.e., U.S. patents, U.S. patent application publications and WIPO publications of international applications) to be applied against the claims as of its effective U.S. filing date. This provision of 35 U.S.C. 102 is mostly utilized when the publication or issue date is too recent for the reference to be applied under 35 U.S.C. 102(a) or (b). In order to apply a reference under 35 U.S.C. 102(e), the inventive entity of the application must be different than that of the reference. Note that, where there are joint inventors, only one inventor \*>needs to< be different for the inventive

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entities to be different and a rejection under 35 U.S.C. 102(e) is applicable even if there are some inventors in common between the application and the reference. **See MPEP 706.02 (f) for a teaching on prior art qualification under 25 USC 102 (e).**

c. Since the filing date of Giorgini (3/4/2003) is more than a year prior to the filing date of applicant's provisional application (03/24/2004), Giorgini does qualify as prior art.

d. Additionally, applicant's provisional application (60/556,209) has no support for curing under ambient pressure conditions. The only discussion of ambient curing is with respect to curing without a heating apparatus. (See page 3 of applicant's provisional specification). There is no disclosure with respect to curing under ambient pressure.

i. Additionally, applicant's provisional application (60/556,209) has no support for the polymeric material being substantially sag resistant.

ii. Thus since Applicant's Provisional Application does not give support for Independent claims 1, 11, and 21—applicant's priority is limited to the Wipo Document (PCT/US2005/010066) which has a priority date of 03/24/2005.

### ***Specification***

1. Examiner with draws objection to the specification as seen in previous office action dated October 5, 2009 due to applicant's amendment of claims 9 and 19.

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4, 6-9, 11-14, 16-19, and 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9, 13-21, and 25 of copending Application No. 12/034,918 in view of Giorgini et al (USP No. 7,138,437—already made of record).

3. Although the conflicting claims are not identical, they are not patentably distinct from each other because both methods disclose a process which utilizes polyurethane

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based polymeric material in order to repair a worn part on a rail assembly. The rail seat and the rail clip are both part of a rail assembly and it is conventional in the art to add a curable material to repair the rail parts in situ. Both applications disclose the use of a polyurethane based material to fill the damaged area and to cure the material using only ambient conditions. It would be obvious to one having the ordinary skill in the art to apply similar repair techniques when fixing either a rail clip or a rail seat as these rail components are typically made of the same construction. Furthermore, Giorgini discloses that gaps in structural members can be filled with polyurethane based materials. **(See abstract)**. As an example, Giorgini discloses that rail die defects can be repaired. Therefore, it would have been obvious to one having the ordinary skill in the art to look for other defective parts in a rail assembly in order to limit the resources and processes needed to complete a full repair on a rail assembly.

This is a provisional obviousness-type double patenting rejection.

**Grounds of Rejection are maintained with minor changes to due applicant's amendments and remarks dated January 20, 2010.**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. *Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giorgini et al (USP No. 7,138,437) in view of Rhodes et al. (USP No. 4,295,259) as evidenced by Young et al.(USP No. 5,173,222).*

5. First with respect to claims 1, 11, and 21-24, applicant has used the transitional phrases "comprising" and "consisting essentially of" with respect to the composition of the poly(urethane-urea) material. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps **"and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In**

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re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original)

(Prior art hydraulic fluid required a dispersant which appellants argued was excluded from claims limited to a functional fluid "consisting essentially of" certain components. In finding the claims did not exclude the prior art dispersant, the court noted that appellants' specification indicated the claimed composition can contain any well-known additive such as a dispersant, and there was no evidence that the presence of a dispersant would materially affect the basic and novel characteristic of the claimed invention. For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase 'consisting essentially of' for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.")).

- a. In this case, Applicant has provided a significant amount of additional materials other than polyols, amines, and polyisocyanates. Applicant has stated additional materials such as, diluents, fillers, compatibilizers, thixotropes, pigments, and anti-settling agents can be added to the inventive composition. **(See page 7 line 13 to page 5 line 8 and table 1 of applicant's specification)**. Since such a wide variety of additional materials can be added to the inventive composition, the limitation consisting essentially of will be interpreted as comprising in the



following claim rejections. **See MPEP 2111.03 for clarification on how consisting essentially of and comprising differ/compare in scope.**

6. Regarding claims 1, 11, and 21 Giorgini teaches a method for repairing structural members by using a polyurethane material (**polyurethane-urea – see column 5 lines 9-19**) to repair the structural members. **(See abstract)**. Giorgini goes on to teach that the structural members can be rail tie assemblies. **(See claims 9, 11, and column 8 lines 24-31)**. Furthermore, Giorgini teaches that a polyurethane mixture is applied to the rail tie void (defect). **(See claim 11 and column 8 lines 12-40)**. Moreover, the polyurethane material is cured to repair the rail tie. **(See column 2 lines 39-42 and example 8 in Column 11 line 64 to column 12 line 18)**. Finally, a sag resistant polymeric repaired article is produced. **(See abstract disclosing the addition of strength enhancers that would give the repaired article excellent strength in order to prevent deformation during a train pass)**.

b. Conventionally, rail seats are part of rail tie assemblies as they insulate the rail from the rail tie. **(See applicant's specification page 1 lines 9-12)**. Furthermore, rail seats can be made of polyurethane. It would have been obvious to apply the teachings of Giorgini to include the repair of the rail seat portion of the rail tie assembly as Giorgini stands for repairing polyurethane based components in a rail tie assembly. As the rail seats and rail tie (defects- see spike hole defects on rail ties as seen in Giorgini-abstract) are both repaired using of polyurethane it would have been obvious for one having the ordinary skill in the art apply Giorgini's process to rail seats.

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- i. Although rail ties themselves are typically concrete, defects in these concrete rail ties such as spike holes are repaired using the process of Giorgini. **(See abstract)**. Polyurethane is added to repair the defects and it would have been obvious for one having the ordinary skill in the art to use polyurethane to fix other polymeric rail tie components such as a rail seats with the same polymeric material (polyurethane).
- c. With respect to claim 1, Giorgini does not expressly teach restoring the damaged rail seat by curing the polymeric material under ambient temperature and pressure conditions.
- d. However, Rhodes teaches a method of repairing (filling) defects (holes) in a railway tie. **(See Abstract)**. Rhodes teaches an In Situ method of plugging a railroad tie by adding a polyurethane foam which is curable at outdoor ambient temperature and pressure to make a rigid repaired article. **(See claim 1)**.
- e. Obviously, the repaired article formed from the process disclosed in Giorgini and Rhodes would have the claimed Sag resistance as well as maintains the shape without substantial run-off as the combination of Giorgini and Rhodes applies the same process and materials as those disclosed in the instant application. The processes disclosed in Giorgini and Rhodes both are for Rail assemblies and one having the ordinary skill in the art would have made sure that the repaired material had adequate sag resistance in order to withstand railroad operations.

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f. Giorgini and Rhodes are analogous art because they are from the same field of endeavor which is repairing or altering a railroad tie assembly. At the time of the invention, it would have been obvious to one having the ordinary skill in the art, having the teachings of Giorgini and Rhodes before him or her, to modify the teachings of Giorgini with the teachings of Rhodes for the benefit of repairing the rail tie on site. The motivation would have been to eliminate the need to bring heating or pressuring equipment on site in order to repair the tie assembly.

Therefore, it would have been obvious to combine Giorgini with Rhodes to repair the rail tie because one would have been motivated to fix the tie on site without the need to move heavy machinery.

g. With respect to claims 1, 11, and 25, the combination of Giorgini and Rhodes do not expressly teach wherein the polyurethane material is to be used to cure defects in rail seats.

h. However, with respect to claims 1, 11, and 25, Young provides motivation that one having the ordinary skill in the art would look to repair defects in a rail tie and rail seat with a similar repairing compound such as epoxy. Young discloses that rail tie assemblies and rail seats need to be restored to original specifications. **(See column 1 lines 50-54)**. Therefore, it would have been obvious to one having the ordinary skill in the art to apply similar repair compositions for rail tie assembly repair to rail seat repair in order to standardize the material needed to repair a rail system. Therefore, it would be obvious to use

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the teachings of Giorgini and Rhodes, in order to repair rail seats with a polyurethane composition.

i. Additionally regarding claim 11, Giorgini does not teach wherein the curing of the polymeric material can be at an ambient temperature as low as 45 F.

ii. However, Rhodes teaches wherein the polyurethane is curable at an outdoor ambient temperature and pressure. **(See claim 1)**.

iii. It is well known that 45 F is a typical outdoor temperature that is commonly encountered as within the typical temperature range of Earth's climate.

j. Additionally regarding claim 21, Giorgini does teach wherein the composition used to repair the rail tie must at least have a polyol and an isocyanate. **(See abstract and column 2 lines 25-27)**. These are the main components and thus Giorgini reads on the claim limitation consisting essentially of polyurethane. Giorgini does not teach wherein the curing is done without the use of non-ambient heat and pressure.

iv. However, Rhodes teaches wherein the polyurethane is curable at an outdoor ambient temperature and pressure. **(See claim 1)**.

v. It would have been obvious to one having the ordinary skill in the art that no additional means for applying heat and pressure need be applied to cure a polymeric material that is curable under ambient conditions.

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7. Regarding claims 2-3 and 12-13, Giorgini does not teach: (1) wherein the damage rail seat is restored without requiring the use of non-ambient heat and (2) wherein the damage rail seat is restored without requiring the use of non-ambient pressure.

k. However, Rhodes teaches wherein the polyurethane is curable at an outdoor ambient temperature and pressure. (See claim 1).

l. It would have been obvious to one having the ordinary skill in the art that no additional means for applying heat and pressure need be applied to cure a polymeric material that is curable under ambient conditions.

8. Regarding claims 4-5 and 14-15, Giorgini teaches wherein the polyurethane composition has a gel time that can be less than 5 seconds. **(See column 3 lines 35-49).**

9. Regarding claims 6 and 16, Giorgini does not explicitly teach wherein the Set Time of the polymeric material is sufficient for contouring the restored rail seat in situ without requiring the use of non-ambient heat.

m. However, Rhodes teaches wherein the repair method is In situ and at ambient pressure and temperature. **(See claim 1),**

n. It would have been obvious to use an in situ repair process to minimize the need for addition machinery or laborers to repair the rail seat. Furthermore, rail roads assembly's typically must be repaired on site in order to minimize the track down time. Thus, it would have been obvious to use a polyurethane material with a reasonable set time that would minimize track down time.

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10. Regarding claims 7-10 and 17-20, the combination of Giorgini and Rhodes do not expressly teach: (1) wherein the rail ties having the restored rail seat maintains the gauge of a rail assembly under dynamic operating conditions; (2) wherein the modulus of the restored rail seat is increased to a level which will resist compressive loading and maintain the rail gauge of the rail assembly; (3) wherein the Elongation of the restored rail seat is at least about 10%; and (4) wherein the Shore D (24 hour) Hardness of the restored rail seat is at least about 65.

o. However, Rhodes teaches that Polyurethane is capable of with standing temperatures up to 300 F, which exceeds the maximum temperature that a railroad would typically see. On the other end, low temperature properties of polyurethane are stable. Therefore, repairing a rail assembly with polyurethane would lead to a rail assembly system that does not deform or fatigue due to temperature or pressure changes. **(See column 7 lines 23-32)**.

p. Additionally, Giorgini teaches that strength enhancers, hydrophobic enhancers, and impact absorption enhancers can be added to polyurethane to make a more stable repaired article. **(See abstract)**. Having better impact absorption will eliminate or minimize structural damages that may occur from railroad vibration or jolts and thus allow the rail assembly to preform under dynamic operating conditions.

q. Furthermore, one of ordinary skill in the art would have obviously recognized that the claimed properties of the restored rail seat would have naturally flowed from the claimed process and the claimed materials used in the

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claimed process. Since, Giorgini in view of Rhodes provides the same process and the same materials as the claimed invention, one of ordinary skill in the art would have obviously recognized, with all things being equal (process and materials), that the process of Giorgini and Rhodes would have produced a restore rail seat having the claimed properties.

11. Regarding claims 22-24, Giorgini teaches wherein the polyurethane-urea mixture consists of at least one polyol compound, at least one isocyanate compound and an isocyanate.

r. **See abstract disclosing that the compositions include part A (polyols) and Part B (Isocyanates).**

s. **See column 3 lines 35-49 disclosing that gelling agents such as polyamines can be used with part A (polyol) composition.**

t. **See column 5 lines 32-35 disclosing use as amines as catalyst.**

### ***Response to Arguments***

1. **Applicant Argument #1:**

a. That the Giorgini reference does not teach using a poly(urethane-urea) material.

2. **Examiner Response to Applicant Argument #1:**

b. However, applicant has described poly (urethane-urea) compositions as at least one polyol, at least one amine, and at least one polyisocyanate. Giorgini

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teaches these materials. **(See abstract, column 3 lines 35-49, and column 5 lines 32-35)**. Additionally, Giorgini teaches wherein the composition which is a reaction of Part A (polyols) and Part B (Isocyanates) use certain catalyst to drive the reaction to a polyurethane-urea hybrid. **(See column 5 lines 5-19)**. In sum, the final product will have urea linkages in the polyurethane composition.

3. **Applicant Argument #2:**

c. The type of material used to repair concrete rail seats is different than repairing holes in a wooden railroad tie.

4. **Examiner Response to Applicant Argument #2:**

d. However, Giorgini provides express motivation for using the claimed composition in wooden repair applications as well as concrete applications. **(See Giorgini column 8 lines 32-40)**. Giorgini teaches the use of a polyurethane based composition that can be used to correct defects of structural members which can be concrete members. **(See abstract and column 8 lines 32-40)**. Giorgini gives an example of a structural member as being a rail tie. "The prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does to place the evidence of Young, within the body of the rejection, rather than at the beginning, not criticize, discredit, or otherwise discourage the solution claimed." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

5. **Applicant Argument #3:**



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e. Applicant argues that the polyurethane material described by Giorgini is only sag resistant after (not during) the curing stage.

6. **Examiner Response to Applicant Argument #3:**

f. First, even if Giorgini was limited to this teaching of being sag resistant only after curing, this is immaterial because applicant has not claimed such a limitation. Applicant's claims only require that that material be sag resistant after restoring. However, the restoring process includes curing and thus is equivalent to the teachings of Giorgini.

7. **Applicant Argument #4:** "That Rhodes is not combinable with Giorgini because Rhodes is drawn to repair of wooden rail ties."

8. **Examiner Response to Applicant Argument #4:**

g. This is immaterial, because examiner has cited the Rhodes teaching for the fact one having the ordinary skill in the art would want a polyurethane composition to be curable at ambient conditions to limit the machinery and time expenditure needed to cure the rail defect on site. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, it is immaterial as to what defect Rhodes is used to cure as Rhodes was cited for the position that it would have been obvious to one having

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the ordinary skill in the art to want the composition to cure on site with minimal cure support.

9. **Applicant Argument #5:** "That the material used in Giorgini would not qualify as consisting essentially of polyurethane material because Giorgini teaches the use of additional components such as strength enhancers."

10. **Examiner Response to Applicant Argument #5:**

h. However, this is not the correct interpretation of the claim limitation "consisting essentially of." The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original) (Prior art hydraulic fluid required a dispersant which appellants argued was excluded from claims limited to a functional fluid "consisting essentially of" certain components. In finding the claims did not exclude the prior art dispersant, the court noted that appellants' specification indicated the claimed composition can contain any well-known additive such as a dispersant, and there was no evidence that the presence of a dispersant would materially affect the basic and novel characteristic of the claimed invention. The prior art composition had the same basic and novel characteristic (increased oxidation resistance) as well as additional enhanced detergent and dispersant characteristics.). "A 'consisting essentially of' claim occupies a middle ground between closed claims that are written in a 'consisting of' format and fully open claims that are drafted in a

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'comprising' format." *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). See also *Atlas Powder v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. vs. Calco, Ltd.*, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). For the purposes of searching for and applying prior art under **35 U.S.C. 102** and **103**, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase 'consisting essentially of' for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). **(See also MPEP 2111.03).**

- i. Furthermore, applicants own invention calls for the use of fillers, compatibilizers, thixotropes, pigments, anti-setting agents and other additives. **(See page 7 lines 21-31).**
- ii. Giorgini discloses that the base component that can be used for the invention is part polyol and part isocyanate which are two main components for producing a polyurethane component. **(See abstract).** Other additives of Giorgini are optional ingredients. **(See column 4 line 39).**

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMJAD ABRAHAM whose telephone number is (571)270-7058. The examiner can normally be reached on Monday through Friday 8:00 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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